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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Qi Huang, et al.**	Attorney Docket No. **A-817 (US)**
Application No.: **10/615,809**	Art Unit No.: **1626**
Filed: **July 8, 2003**	Examiner: **Joseph R. Kosack**
Title: **SUBSTITUTED ANTHRANILIC AMIDE DERIVATIVES AND METHODS OF USE**	

PETITION PURSUANT TO 37 C.F.R. § 1.181 TO WITHDRAW THE FINALITY OF THE PENDING ACTION

Mail Stop: After Final/Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicants respectfully submit that the Examiner has prematurely issued a Final Office Action in this case, and request that the Director withdraw the finality of the action. This petition is based on the following facts:

- As part of the Examiner's Restriction Requirement mailed 12/07/05 the Examiner required Applicants to select a species. The Restriction Requirement went on to state: "...upon election of a single compound the Office will review the claims and disclosure to determine the scope of the independent invention encompassing the elected compound..." (Restriction Requirement, page 3, lines 20-22). Moreover, the Restriction Requirement further went on to provide: "A clear statement of the

CERTIFICATE OF FACSIMILE TRANSMISSION

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January 19, 2007
Date

Julie M. Balot

examined invention... will be set forth in the first action on the merits. **Note that the restriction requirement will not be made final until such time as applicant is informed of the full scope of compounds ... under examination.**" (Restriction Requirement, page 4, lines 7-11) (emphasis added).

- In the first action on the merits, mailed 4/13/06, the Examiner first set forth his self-determined "scope of the invention", which limited the examined subject matter to compounds in which, *inter alia*, "R^3 is a 6-membered ring with ring members consisting of only carbon and nitrogen, optionally substituted as defined, optionally unsaturated as defined;" (4/13/06 Office Action, page 3, lines 1-3). The Examiner went on to state: "As a result of the election and the corresponding scope of the invention defined supra, the remaining subject matter of Claims 1-12, 16-19, 23-27, 29-30, 32, 34 and 36 are withdrawn from further consideration ... as being drawn to non-elected inventions." (4/13/06 Office Action, page 3, lines 5-8.)
- In their response to the first action on the merits, filed 8/11/ Applicants traversed the Examiner's self-determined "scope of the invention" which constituted such an integral part of the Restriction Requirement, and which was revealed to Applicants for the first time in the 4/13/06 Office Action. Specifically, it was stated: "Applicants respectfully submit that the Examiner's limitation of R^3 is not consistent with the language of the claims at issue. Specifically, the words **"6 membered ring with ring members consisting of only carbon and nitrogen..."** appear nowhere in the specification or claims, and their insertion into the claims raises potential issues of new matter. At a minimum, Applicants are entitled to a limitation of R^3 that speaks in the same terms of that originally contained in the specification and claims. In this case, Applicants have used the term: **"substituted or unsubstituted 5-6 membered heterocyclyl..."**.and Applicants submit that the use of these terms is more appropriate than the language that has been constructed, Ex parte , by the Examiner.
- The Examiner never responded to Applicants' traversal, and never stated that the Restriction Requirement had been made final.

As a result of the foregoing facts, there is significant uncertainty as to the scope of the invention currently being examined. For example, where the Examiner states in the pending Final Office Action: "Claims 1-3, 5-7, 9-11, 17, 19-20, 23, 24, 29, 30-32, 34 and 36 are objected to for containing elected and non-elected subject matter" (Final Action, page 4, lines 1-2), it is unclear if the Examiner is intending that a complete response to the action requires Applicants to amend the definition of R^3 to conform to the original "scope of the invention" set forth in the first action on the merits. Applicants have not entered such an amendment herein, because they believe the limitation would be improper, and the Restriction Requirement was never made final.

As provided in Section 706.07 of the MPEP, before a final rejection can be properly made, the issues should be clearly developed between the Examiner and the Applicant. As described above, such is not the case here. Further, as provided in Section 706.07(c), questions as to the prematureness of a final rejection are petitionable under 37 C.F.R. § 1.181.

Applicants do not believe that a fee is required for the submission of this petition, as their review of 37 C.F.R. § 1.17 does not appear to contain an entry relating to petitions under 37 C.F.R. § 1.181. However, in the event that the Office determines that a fee is required for the submission of this petition, the Commissioner is hereby authorized to charge any fees due, or credit any overpayments to Deposit Account No. 01-0519.

Respectfully submitted,

Dated: January 19, 2007

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